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SEP 29 2010

OFFICE OF PETITIONS

In re Application of	:	
Cleland et al.	:	
Application No. 10/080502	:	ON APPLICATION FOR
Filing or 371(c) Date: 02/22/2002	:	PATENT TERM ADJUSTMENT
Attorney Docket Number:	:	
146392000500	:	

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)," filed June 9, 2010. Applicants petition for reconsideration of the patent term adjustment calculation to 115 days, not eighty (80) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction based upon (1) an assertion that the Office erred in failing to calculate a delay of 94 days, (2) an assertion that the Office erred in failing to calculate an adjustment of 100 days, and (3) on the basis that the Office will take in excess of three years to issue this patent.

The Application for Patent Term Adjustment Including Request for Reconsideration of Patent Term Adjustment ("PTA") under 37 CFR 1.705(b), as it relates to the assertion that the Office erred in failing to calculate delays of 94 days and 100 days, is **GRANTED to the EXTENT INDICATED.**

The Application for Patent Term Adjustment Including Request for Reconsideration of Patent Term Adjustment ("PTA") under 37 CFR 1.705(b), as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE.**

On May 3, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is eighty (80) days.

On June 9, 2010, applicant timely submitted the instant application for patent term adjustment¹. Applicants request that the Determination of Patent Term Adjustment be corrected from eighty

¹ PALM records show that the Issue Fee payment was received in the Office on June 9, 2010.

(80) days, as indicated on the Determination of PTA mailed May 3, 2010, to an adjustment of 115 days. Applicants aver that the Office failed to calculate a delay of 94 days in connection with the response to a non-final Office action, filed November 6, 2006, and that the Office erred in failing to calculate an adjustment in connection with the mailing of a Notice of Allowance and Issue Fee Due, mailed May 3, 2010, and (2) on the basis that the Office will take in excess of three years to issue this patent.

As to the assertion that the Office erred in failing to calculate a delay of 94 days in connection with the response to a non-final Office action, filed November 6, 2006, a review of Office records confirms that the Office mailed a non-final Office action on May 4, 2006. Applicants filed a reply to the Office action on November 6, 2006. The reduction commenced September 5, 2006, the day after the date that is three months after the date of mailing of the non-final Office action, and ending on the date the reply was filed, November 6, 2006. As such, pursuant to 37 CFR 1.704(b), the application is properly assessed a reduction of 94 days.

As to the assertion that the Office erred in failing to calculate an adjustment of 100 days in connection with the Notice of Allowance and Issue Fee Due, mailed May 3, 2010, Applicant avers that the Office mailed a final Office action on December 9, 2009; however, the final Office action was supplanted (replaced) by the Notice of Allowance and Issue Fee Due, mailed May 3, 2010. Applicants provide that in an interview summary mailed May 3, 2010, the Examiner stated, inter alia, that the the first action final was erroneously mailed.

Applicants' argument is not persuasive. On December 9, 2009, the Office issued an action as a result of the examination conducted pursuant to 35 U.S.C. 131. The subsequent action in this case, the Notice of Allowance and Issue Fee Due, does not negate the fact that a first Office action was mailed on December 9, 2009. Accordingly, the period of examination delay was properly calculated based on the December 9, 2009 date.

A further review of the Application for Patent Term Adjustment reveals that Applicants have erroneously calculated a delay of 63 days in connection with the response to the final Office action mailed March 23, 2009. Applicants filed an Amendment in response to the final Office action on August 25, 2009; however, the Amendment failed to place the application in condition for allowance. Applicants were so notified in an Advisory Action mailed September 21, 2009. Applicants thereafter filed a complete and proper reply to the final Office action on September 23, 2009. The reduction of 92 days pursuant to 37 CFR 1.704(b) beginning on the day after the date that is three months after the date of mailing of the Office action, June 24, 2009, and ending on the date the reply was filed, September 23, 2009, was properly assessed to Applicants.

In view thereof, as of the time of allowance, the application is entitled to an overall patent term adjustment of zero days (adjustments totaling 541 days less reductions totaling 555 days).

As to the Office's failure to issue the patent within 3 years of the filing date, knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been

determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee².

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent, including any request as it relates to the Office's failure to issue the patent within 3 years of the filing date, must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and *must* include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

² For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

Telephone inquiries specific to this matter should be directed to Attorney Derek Woods at (571) 272-3232.



Anthony Knight
Director
Office of Petitions

Enclosure: Copy of Adjustment PAIR Calculations



Patent Term Adjustments



PTA/PTL Information Patent Term Adjustment Patent Term Extension

Application Number*: 10080502 Search Explanation of PTA Calculation Explanation of PTE Calculation

PTA Calculations for Application: 10080502

Application Filing Date 02/22/2002	Overlapping Days Between (A and B) or (A and C) 0
Issue Date of Patent	Non-Overlapping USPTO Delays: 541
A Delays 541	PTO Manual Adjustment: 94
B Delays 0	Applicant Delay (APPL): 461
C Delays 0	Total PTA (days) 0

* - Sorted Column

File Contents History

Action Number	Action Recorded Date	Action Due Date	Action Code	Action Description	Duration PTO	Duration APPL	Parent Action Number
149	09/28/2010		P028	Adjustment of PTA Calculation by PTO	24	0	0
129	05/03/2010		MN/A	Hall Notice of Allowance		0	0
128	05/03/2010		N/E	Notice of Allowance Data Verification Completed		0	0
127	05/03/2010		DOCK	Case Docketed to Examiner in GAU		0	0
126	05/03/2010		IREV	Issue Revision Completed		0	0
125	05/03/2010		DVER	Document Verification		0	0
123	05/03/2010		CHTA	Notice of Allowability		0	0
122	03/22/2010		HEXIN	Hall Examiner Interview Summary (PTOL - 413)		0	0
124	03/09/2010		EXIN	Examiner Interview Summary Record (PTOL - 413)		0	0
120	03/09/2010		EXIN	Examiner Interview Summary Record (PTOL - 413)		0	0
121	01/13/2010		EXIN	Examiner Interview Summary Record (PTOL - 413)		0	0
116	01/13/2010		EXIN	Examiner Interview Summary Record (PTOL - 413)		0	0
115	12/09/2009		MCTFR	Hall Final Rejection (PTOL - 326)		0	0
114	12/07/2009		CTFR	Final Rejection		0	0
113	10/13/2009		LET	Miscellaneous Incoming Letter		0	0
112	10/07/2009		FWDX	Date Forwarded to Examiner		0	0
110	10/07/2009		FWDX	Date Forwarded to Examiner		0	0
108	10/07/2009		ABN9	Disposal for a RCE / CPA / R129		0	0
111	09/23/2009		ANPR	RCE - AF Processed		0	0
109	09/23/2009	06/23/2009	RCEX	Request for Continued Examination (RCE)	22	100	0
107	09/23/2009		BRCE	Workflow - Request for RCE - Begin		0	0
106	09/21/2009		MCTAV	Hall Advisory Action (PTOL - 303)		0	0
104	09/21/2009		CTAV	Advisory Action (PTOL-303)		0	0
105	09/18/2009		EXIN	Examiner Interview Summary Record (PTOL - 413)		0	0
103	08/27/2009		FWDX	Date Forwarded to Examiner		0	0
102	08/25/2009		A.ME	Amendment after Final Rejection		0	0
101	08/25/2009		XT/G	Request for Extension of Time - Granted		0	0
100	03/23/2009		MCTFR	Hall Final Rejection (PTOL - 326)		0	0
99	03/19/2009		CTFR	Final Rejection		0	0
95	01/28/2009		FWDX	Date Forwarded to Examiner		0	0
94	01/09/2009	10/09/2008	A...	Response after Non-Final Action	22	60	0
98	10/30/2008		IDSC	Information Disclosure Statement considered		0	0
93	10/30/2008		XT/G	Request for Extension of Time - Granted		0	0
92	10/30/2008		RCAP	Reference capture on IDS		0	0
91	10/30/2008		M844	Information Disclosure Statement (IDS) Filed		0	0
90	10/30/2008		WIDS	Information Disclosure Statement (IDS) Filed		0	0
97	10/16/2008		IDSC	Information Disclosure Statement considered		0	0
96	10/16/2008		M844	Information Disclosure Statement (IDS) Filed		0	0
89	10/16/2008		WIDS	Information Disclosure Statement (IDS) Filed		0	0
88	07/09/2008		MCTNF	Hall Non-Final Rejection		0	0
87	07/07/2008		CTNF	Non-Final Rejection		0	0
85	05/02/2008		FWDX	Date Forwarded to Examiner		0	0
86	04/08/2008		IDSC	Information Disclosure Statement considered		0	0
84	04/08/2008		A...	Response after Non-Final Action		0	0
83	04/08/2008		WIDS	Information Disclosure Statement (IDS) Filed		0	0
82	02/07/2008		MCTNF	Hall Non-Final Rejection		0	0
81	02/04/2008		CTNF	Non-Final Rejection		0	0
76	11/29/2007		FWDX	Date Forwarded to Examiner		0	0
74	11/29/2007		FWDX	Date Forwarded to Examiner		0	0
72	11/29/2007		ABN9	Disposal for a RCE / CPA / R129		0	0
69	11/02/2007		HEXIN	Hall Examiner Interview Summary (PTOL - 413)		0	0
80	10/31/2007		IDSC	Information Disclosure Statement considered		0	0
78	10/31/2007		M844	Information Disclosure Statement (IDS) Filed		0	0
77	10/31/2007		FEE	Fee Payment Recorded (fees filed separately e.g. not with original papers, etc.)		0	0
75	10/31/2007		AMSB	Amendment Submitted/Entered with Filing of CPA/RCE		0	0
71	10/31/2007		RCAP	Reference capture on IDS		0	0
70	10/31/2007		M844	Information Disclosure Statement (IDS) Filed		0	0
68	10/31/2007		WIDS	Information Disclosure Statement (IDS) Filed		0	0
67	10/31/2007		BRCE	Workflow - Request for RCE - Begin		0	0
66	10/30/2007		EXIN	Examiner Interview Summary Record (PTOL - 413)		0	0
65	10/09/2007		MCTAV	Hall Advisory Action (PTOL - 303)		0	0
64	10/05/2007		CTAV	Advisory Action (PTOL-303)		0	0
62	10/03/2007		FWDX	Date Forwarded to Examiner		0	0
79	09/28/2007		IDSC	Information Disclosure Statement considered		0	0
63	09/28/2007		M844	Information Disclosure Statement (IDS) Filed		0	0
61	09/28/2007		AP/A	Amendment/Argument after Notice of Appeal		0	0
60	09/28/2007	06/29/2007	N/AP	Notice of Appeal Filed	21	55	0
59	09/28/2007		XT/G	Request for Extension of Time - Granted		0	0
58	09/28/2007		WIDS	Information Disclosure Statement (IDS) Filed		0	0
57	09/25/2007		CAD	Correspondence Address Change		0	0
56	09/25/2007		PA...	Change in Power of Attorney (May Include Associate POA)		0	0
55	03/29/2007	03/06/2007	MCTFR	Hall Final Rejection (PTOL - 326)	23	50	0
54	03/27/2007		CTFR	Final Rejection		0	0
53	01/31/2007		FWDX	Date Forwarded to Examiner		0	0
51	01/31/2007		FWDX	Date Forwarded to Examiner		0	0
48	01/31/2007		MNRAB	Hall Notice of Rescinded Abandonment		0	0
47	01/31/2007		NRA8	Notice of Rescinded Abandonment in TCA		0	0
46	12/20/2006		MPREV	Hall-Petition to Revive Application - Granted		0	0
52	11/28/2006		SA...	Supplemental Response		0	0
45	11/28/2006		PET	Petition Entered		0	0
44	11/16/2006		MABN2	Hall Abandonment for Failure to Respond to Office Action		0	0
43	11/13/2006		ABN2	Aband. for Failure to Respond to O. A.		0	0
50	11/06/2006		A...	Response after Non-Final Action		0	0
49	11/06/2006		XT/G	Request for Extension of Time - Granted		0	0
42	05/04/2006		MCTNF	Hall Non-Final Rejection		0	0
41	05/01/2006		CTNF	Non-Final Rejection		0	0
40	03/16/2006		FWDX	Date Forwarded to Examiner		0	0
38	03/16/2006		FWDX	Date Forwarded to Examiner		0	0
36	03/16/2006		ABN9	Disposal for a RCE / CPA / R129		0	0
32	01/31/2006		MABN2	Hall Abandonment for Failure to Respond to Office Action		0	0

31	01/31/2006	HEXIN	Mail Examiner Interview Summary (PTOLC 413)		0
29	01/30/2006	ABN2	Aband. for Failure to Respond to O. A.		0
30	01/27/2006	EXIN	Examiner Interview Summary, Record (PTOLC 413)		0
39	01/26/2006	AMSB	Amendment Submitted/Entered with Filing of CPA/RCE		0
37	01/26/2006	10/26/2005	RCEX	Request for Continued Examination (RCE)	22 27
28	01/26/2006		BRCE	Workflow - Request for RCE - Begin	0
27	07/26/2005	01/27/2005	MCTFR	Mail Final Rejection (PTOLC 526)	100 22
26	07/21/2005		CTFR	Final Rejection	0
23	10/14/2004		FWDX	Date Forwarded to Examiner	0
20	10/14/2004		CAD	Correspondence Address Change	0
19	10/14/2004		PA..	Change in Power of Attorney (May Include Associate POA)	0
18	10/06/2004		CADB	Correspondence Address Change	0
17	10/06/2004		CADB	Correspondence Address Change	0
16	10/06/2004		CADB	Correspondence Address Change	0
25	09/27/2004		RCAP	Reference capture on IDS	0
24.7	09/27/2004	09/27/2004	M944	Information Disclosure Statement (IDS) Filed	22
24	09/27/2004		WIDS	Information Disclosure Statement (IDS) Filed	0
22	09/27/2004	06/25/2004	A..	Response after Non-Final Action	24 15
21	09/27/2004		XI/G	Request for Extension of Time Granted	0
15	03/25/2004	04/22/2003	MCTNF	Mail Non-Final Rejection	228 -1
14	03/22/2004		CTNF	Non-Final Rejection	0
13	12/17/2003		TSSCOMP	IPW TSS Processing by Tech Center Complete	0
12	12/17/2003		RCAP	Reference capture on IDS	0
10.7	10/07/2002		M944	Information Disclosure Statement (IDS) Filed	0
10	10/07/2002		WIDS	Information Disclosure Statement (IDS) Filed	0
9	07/22/2002		DOCK	Case Docketed to Examiner in GAU	0
7	06/06/2002		OTPE	Application Dispatched from OTPE	0
6	06/04/2002		COMP	Application Is Now Complete	0
11.7	05/23/2002		M944	Information Disclosure Statement (IDS) Filed	0
11	05/23/2002		WIDS	Information Disclosure Statement (IDS) Filed	0
5	05/23/2002		FLFEE	Payment of Additional Filing Fee/Proexam	0
4	05/23/2002		OATHDECL	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic	0
3	03/26/2002		INCD	Notice Rejected Application Incomplete Filing Date Assigned	0
2	03/07/2002		SCAN	IPW Scan & PACR Auto Security Review	0
1	02/22/2002		EXOR	Initial Exam Team no	0

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